

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY J. CHAINER, WAYNE J. SOHN and EDWARD J.
YARMCHUK

Appeal No. 1998-2517
Application 08/317,129

ON BRIEF

Before JERRY SMITH, BARRETT, and BLANKENSHIP, Administrative
Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 4, 24, 25, 29, 32, 52, 53 and 57-74, which constitute all the claims remaining in

the application.

The disclosed invention pertains to a method and apparatus for determining which of a plurality of recording heads in a recording device writes the widest track.

Representative claim 24 is reproduced as follows:

24. A method for determining which of a plurality of recording heads in a recording device having a plurality of storage media writes the widest, each of said plurality of storage media having at least one of said plurality of recording heads associated therewith, said method comprising the steps of:

writing a first transition with each of said plurality of recording heads;

writing a second transition with one of said plurality of recording heads, said second transition being written at a predetermined distance from a first transition written with said one of said plurality of recording heads;

positioning each of said plurality of recording heads using said second transition; and

reading and comparing with said positioned recording heads an amplitude signal associated with each of said first transitions and determining therefrom which of said plurality of recording heads writes the widest.

The examiner relies on the following references:

Oliver et al. (Oliver)	4,414,589	Nov. 08, 1983
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Miyazaki (Japanese Kokai) 63-63183 Mar. 19, 1988

Katz, "Erase Profiles of Floppy Disk Heads," IEEE Transactions on Magnetism, Vol. Mag-20, No. 4, July 1984, pages 528-541.

"Regenerative Clock Technique For Servo Track Writers," IBM Technical Disclosure Bulletin, Vol. 33, No. 5, October 1990, pages 310-311 (IBM).

The following rejections are before us on appeal:

1. Claims 24, 25, 52, 53, 59 and 64 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Miyazaki.

2. Claims 60 and 65 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Miyazaki in view of Katz.

3. Claims 1, 4, 29, 32, 57, 61 and 62 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Miyazaki in view of IBM.

4. Claims 58 and 63 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Miyazaki in view of IBM and Katz.

5. Claims 1, 4, 29, 32, 57 and 62 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of

Miyazaki in view of IBM and Oliver.

6. Claims 58 and 63 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Miyazaki in view of IBM, Oliver and Katz.

7. Claims 66-74 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Miyazaki in view of IBM and Katz.

8. Claims 66-74 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Miyazaki in view of IBM, Oliver and Katz.

Rather than repeat the arguments of appellants or the examiner, we make reference to the main brief¹ and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise,

¹ Appellants filed a reply brief on April 3, 1997 which was denied entry by the examiner. Accordingly, we have not considered this reply brief in the preparation of this decision.

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reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the prior art applied by the examiner does not support the rejection of any of claims 1, 4, 24, 25, 29, 32, 52, 53 and 57-74. Accordingly, we reverse.

We consider first the rejection of claims 24, 25, 52, 53, 59 and 64 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Miyazaki. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert.

denied, 469 U.S. 851 (1984).

This rejection is briefly set forth on page 5 of the answer. Appellants argue that there are elements recited in these claims which are not disclosed in Miyazaki. Specifically, appellants argue that the cooperative relationship recited in the claims for determining the widest head is clearly missing from Miyazaki. Appellants also argue that the determination in Miyazaki of the head having the greatest read signal amplitude is not the same as determining which head writes the widest because all heads do not have the same sensitivity [brief, pages 8-15]. In response the examiner amplifies on how he perceives the disclosure of Miyazaki to meet the invention of claim 24 [answer, pages 12-14].

After a careful review of the Miyazaki disclosure, the claimed invention, the arguments of appellants and the arguments of the examiner, we agree with appellants that Miyazaki fails to disclose every element of the claimed invention. We will not explain our position in detail because it corresponds substantially to appellants' arguments as set

forth in the main brief. Although there are some similarities between the disclosure of Miyazaki and appellants' disclosed invention, the fact remains that Miyazaki does not determine which of a plurality of recording heads in a recording device writes the widest, and Miyazaki certainly does not make such a determination in the specific manner recited in these claims. First, Miyazaki looks for the head with the greatest write signal magnitude, not the head that writes the widest. As noted by appellants, these two determinations are not equivalent. Miyazaki simply discloses that for a given magnetic head and surface, the write signal amplitude is proportional to the track width of the magnetic head. This disclosure in no way suggests that the write signal amplitude of different heads can be used to determine which head writes the widest. Second, the specific sequence of steps recited in representative claim 24 is simply not disclosed, taught or suggested by the disk positioning device of Miyazaki. Even if one could speculate that Miyazaki achieves the same result as the claimed invention, which is not supported by this record, that would not be a basis to find anticipation of the

invention as claimed.

In summary, we agree with appellants that Miyazaki does not disclose every feature of the invention set forth in claims 24, 25, 52, 53, 59 and 64. Therefore, the rejection of these claims under 35 U.S.C. § 102 is not sustained.

We now consider the various rejections under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in

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the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to

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make in the brief have not been considered [see 37 CFR
§ 1.192(a)].

Each of the examiner's rejections of the claims under 35 U.S.C. § 103 fundamentally relies on Miyazaki as the primary reference. For reasons discussed above, Miyazaki does not provide the teachings attributed to it by the examiner. We also agree with appellants that the teachings of Katz, IBM, and/or Oliver do not cure the basic deficiencies of Miyazaki discussed above. Therefore, the collective teachings of the applied references fail to establish a prima facie case of obviousness. Accordingly, we do not sustain any of the examiner's rejections of the claims under 35 U.S.C. § 103 based upon the applied references.

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In conclusion, we have not sustained any of the examiner's rejections of the appealed claims. Therefore, the decision of the examiner rejecting claims 1, 4, 24, 25, 29, 32, 52, 53 and 57-74 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	

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